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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,423	04/23/2001	John Carney	007412.01058	5451
71867 7590 06/16/2010 BANNER & WITCOFF, LTD ATTORNEYS FOR CLIENT NUMBER 007412 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051				
EXAMINER				
DUFFIELD, JEREMY S				
ART UNIT		PAPER NUMBER		
2427				
MAIL DATE		DELIVERY MODE		
06/16/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/841,423

Applicant(s)

CARNEY ET AL.

Examiner

JEREMY DUFFIELD

Art Unit

2427

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 6, 8, 13 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 6, 8, 13 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/C2)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 April 2010 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 3, 6, 8, and 13 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claim 1 is objected to because of the following informalities: Claim 1, line 10, "the first personalization data:" needs to be changed to --the first personalization data--. Claim 1, lines 11-12, "of receivers. transmitting the" needs to be changed to --of receivers, transmitting the--. Appropriate correction is required.

4. Claim 13 is objected to because of the following informalities: Claim 13, line 7, "with the respective second personalization data" lacks sufficient antecedent basis for the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 13 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 13 sets forth a "machine-readable medium." However, the specification as originally filed does not explicitly define the machine-readable medium by stating that it includes, but is not limited to a number of various mediums (Para. 65). The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. *See In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable storage media (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is absent an explicit definition or is silent. *See* MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter*

Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2. This rejection may be overcome by amending the claim to include a "non-transitory" machine-readable medium.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 6, 8, 13, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunkel (US 7,100,183) in view of Eldering (US2005/0193410).

Regarding claim 1, Kunkel teaches a method for selectively providing personalized interactive TV content comprising (Col. 4, lines 33-64):

broadcasting the interactive TV content via a first broadcast stream, the interactive TV content including tagged content, the tagged content being marked by a tag comprising first personalization data, i.e. content is tagged with demographic codes (Col. 3, lines 35-50);

determining if the tagged content is targeted for a specific group of receivers based upon the first personalization data (Col. 3, line 59-Col. 4, line 24; Col. 6, lines 4-8); and

upon determining the tagged content is targeted for the specific group of receivers, transmitting the interactive TV content via the first broadcast stream to

the specific group of receivers, i.e. content is sent to users and filtered based on the demographic codes (Col. 3, line 35-Col. 4, line 24; Col. 6, lines 4-8).

Kunkel does not clearly teach receiving interactive TV content via a first broadcast stream; and transmitting the interactive TV content via a second broadcast stream to the specific group of receivers.

Eldering teaches receiving interactive TV content via a first broadcast stream, i.e. receiving content at a head-end from a centralized point (Para. 37, 51, 52);

determining if the content is targeted for a specific group of receivers based upon first personalization data (Para. 33-34, 37, 41, 51); and

upon determining the content is targeted for the specific group of receivers, transmitting the interactive TV content via a second broadcast stream to the specific group of receivers, i.e. routing the content to the correct node or receiver based upon the assigned group or subgroup (Para. 30, 37, 51-52).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kunkel to include receiving interactive TV content via a first broadcast stream; and transmitting the interactive TV content via a second broadcast stream to the specific group of receivers, using the known method of routing content based upon assigned groups, as taught by Eldering, in combination with the interactive content tagging system of Kunkel, for the purpose of conserving bandwidth while also providing effective advertising.

Regarding claim 3, Kunkel in view of Eldering teaches selectively broadcasting the second personalization data to the at least one receiver (Kunkel-Col. 3, line 59-Col. 4, line 24).

Regarding claim 6, claim is analyzed with respect to claim 1.

Regarding claim 8, claim is analyzed with respect to claim 3.

Regarding claim 13, claim is analyzed with respect to claim 1. Kunkel in view of Eldering further teaches the tagged content is personalized for display only by one or more receivers provided with respective second personalization data (Kunkel-Col. 3, line 59-Col. 4, line 46; Eldering-Para. 33, 36).

Regarding claim 21, Kunkel in view of Eldering teaches selectively receiving second personalization data by at least one receiver of the specific group of receivers, via a third broadcast stream, the second personalization data including data to permit the at least one receiver to output the tagged content, e.g. demographic information may be downloaded to the set-top box from the head-end (Kunkel-Col. 3, lines 14-28; Col. 3, line 59-Col. 4, line 24).

Regarding claim 22, claim is analyzed with respect to claim 21.

Regarding claim 23, claim is analyzed with respect to claim 21.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEREMY DUFFIELD whose telephone number is (571)270-1643. The examiner can normally be reached on Mon.-Fri. 8:00 A.M.-5:30 P.M. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Scott Beliveau/

Supervisory Patent Examiner, Art Unit 2427